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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/528,170	02/01/2000	Laurent Ferenczi	S.4369	9405

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EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/528,170	Applicant(s) Ferenczi et al.	
	Examiner O'Connor	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 4, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 1, 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment and arguments filed by applicant on January 4, 2006 in reply to the previous Office action on the merits, mailed October 4, 2005.
2. The amendment of claims 1, 4, 8, 10, 12, 16, 19, 23, and 24 by applicant in the reply filed January 4, 2006 is hereby acknowledged.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in-
 - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
 - (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-4, 8, 9, 11-14, 17, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by O'Neil et al. (US 4,812,629).

O'Neil et al. disclose an installation 10 for monitoring containers 11, each equipped with an information medium 102, comprising at least one delimited storage zone 12 for the containers including at least one access passage for a user to directly access the entire storage zone, at least one device 110 for identifying the user and with at least one reading device 97 able to read the information on the containers' 11 information medium 102, and data exploitation means 104 exploiting at least information read by the reading device 97.

Regarding claim 2, in the installation of O'Neil et al., the exploitation means comprise means (148) for evaluating the stock of containers warehoused in the storage zone.

Regarding claim 3, in the installation of O'Neil et al., the exploitation means comprise means for determining the positions of the containers in the storage zone (103 ; 300).

Regarding claim 4, in the installation of O'Neil et al., the storage zone (103 ;...303) comprises at least one facility (100) for distributing containers (107, 109, 111) comprising a storage space (103) for the containers and means of authorization (140) of removal of at least one container disposed in said storage space (103), said means of authorization (140) comprising, on the one hand, disabling means (144), switchable between a position for disabling the containers disposed in the storage space (103) and a distribution position in which at least one container is authorized to be removed, and, on the other hand, means (146) of control of said disabling means (144).

Regarding claim 8, in the installation of O'Neil et al., the means (148) for evaluating the stock comprise means (150) for memorizing the status of the stock, which are linked to the transmission means (127) for transmitting a status of the stock to the replenishment center (129), this status comprising the number and the type of full containers (107, 109) of the stock.

Regarding claim 9, in the installation of O'Neil et al., the stock evaluation means (148) comprise means (154) for registering a removal or a placement of a container so as to detect whether a user is removing or returning a container.

Regarding claim 11, in the installation of O'Neil et al., the storage zone (103) comprises separate locations (113) intended each to receive a container (107, 109, 111), a device (13) for reading the information on the containers' information media (29) being disposed in each location (103) and linked to the means (154) for registering a removal or a placement of a container so as to output to these latter means a signal indicating the presence of a container in the relevant location (103) so as to detect whether a user has removed or returned a container.

Regarding claim 12, in the installation of O'Neil et al., the stock evaluation means (148) comprise calculation means (158) connected to the means (150) for memorizing the status of the stock, to the means (154) for registering a removal or a placement of a container as well as to the device or devices (13) for reading the information on the containers' information media (29), so as to evaluate the stock of empty and full containers, the number and the type being registered by the reading device or devices (13), and on the basis of the information about a removal or a placement of a container registered by said means (154) for registering a removal or a placement of a container.

Regarding claim 13, in the installation of O'Neil et al., the authorization means (140) comprise means (142) for identifying a user which are connected to the stock evaluation means (148), and wherein the stock evaluation means (148) comprise means (160) for memorizing the codes for identifying removed and/or returned containers, these codes being read by the reading device (13) and associated with the identity of a user output by the identification means (142) with a view to the invoicing of the user.

Regarding claim 14, in the installation of O'Neil et al., the distribution facility (100) comprises means of reception and remote checking of the operation of the facility (100), which are intended to receive replenishment center (129) control signals.

Regarding claim 17, in the installation of O'Neil et al., the exploitation means (17) comprise means (57) for memorizing a list of geographical positions of sites to be replenished containerwise and means (59) for comparing the geographical position output during a container delivery.

Regarding claim 22, in the installation of O'Neil et al., the information medium (7) comprises a bar-code tag (9), and wherein the reading device (13) comprises a bar-code reader (15).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5-7, 10, 15, 16, 18-21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Neil et al. (US 4,812,629), in view of McCarrick et al. (US 5,953,682).

Regarding claims 5-7, O'Neil et al. disclose an installation 10 for monitoring containers 11, as applied above in the rejection of claim 1 under 35 U.S.C. 102(b), but while the installation of O'Neil et al. includes reporting inventory status of containers in the installation to a central site, which can indeed be considered means for "triggering" an order, the installation of O'Neil et al. fails to include means for "transmitting a replenishment order" when the inventory falls below any particular threshold. However, McCarrick et al. disclose an arrangement that includes transmitting a normal or emergency replenishment order when inventory respectively falls to a normal or emergency reordering threshold. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the installation of O'Neill et al. so as to include means for transmitting a normal or emergency replenishment order when inventory respectively falls to a normal or emergency reordering threshold, in accordance with the teachings of McCarrick et al., in order to avoid running out of inventory unexpectedly, as taught in the disclosure of McCarrick et al.

Regarding claim 10, the installation of O'Neil et al. comprises only one read head instead of two, but is able to determine whether the container is being returned or taken because the installation itself moves the container past the read head, therefor knowing which way it is moving. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have added a second head in order to enable the installation to know which way the container was moving if the container were being moved by hand, since that would be the only

feasible way of making such a determination, and since such a determination is necessary to operation of the installation as disclosed, and since making such a modification could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and lastly, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Regarding claims 15-16, 23, and 24, O'Neil et al. do not explicitly disclose who initially attaches the information media, but, in any event, the information media of O'Neil et al. is not an electronic tag. However, the information media of McCarrick et al. is indeed an electronic tag and the attachment to the container is performed as part of the disclosed invention. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have attached and used electronic tags instead of bar codes, in accordance with the teachings of McCarrick et al., in order to enable the installation to usefully write data to the tag, in addition to only reading information from the tag, as taught by McCarrick et al.

Regarding claims 18-21, O'Neil et al. do not teach that the installation can locate the containers on an industrial site, once the containers are removed from the installation. However, the disclosure of McCarrick et al. includes means for locating the deployed containers on an industrial site. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the installation of O'Neil so as to include means for locating the deployed containers on an industrial site, in accordance with the teachings of

McCarrick et al., in order to monitor the quantity of gas within the deployed containers, as the gas was being consumed over time, as explicitly taught by McCarrick et al.

Response to Arguments

7. Applicant's arguments filed Jan. 4, 2006 have been fully considered but are not persuasive.
8. Regarding the argument that O'Neil et al. do not disclose a user accessing an entire storage zone and all of the plural containers stored therein, a recitation of an intended use of a claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.
10. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

February 24, 2006

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "2/24/06" written in a similar cursive style.

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627